

## THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
Reinhard Leigraf, et al.	)	Group: 1713
Serial No.: 10/587,617	)	
Filed: July 27, 2006	)	
Title: METHOD AND SYSTEM FOR PRODUCING	)	Examiner: Tran, Binh X.
A WOOD-FREE COATED MATTE OR SEMI-MATTE	)	
PAPER WEB	)	

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Sir:

Applicants request a review of the final rejection in the above-identified application. No amendments are being filed with this request. This Pre-Appeal Brief Request for Review is being filed concurrently with a Notice of Appeal from the Examiner's Decision dated May 12, 2010, finally rejecting claims 26-30, 32-38 and 52; and the Advisory Action dated July 22, 2010. Claims 26-30, 32-38 and 52 are pending and rejected, and claims 39-51 are withdrawn from consideration in this application. The panel of Examiners is requested to review the legal and factual basis of the rejections for the reasons stated below.

Claims 26-29, 32-34, and 37 have been rejected under 35 USC § 103(a) as being unpatentable over International Publication WO 02/103109 (Korhonen) in view of US Patent Application Publication No. 2003/0178165 (Bobsein, et al.).

Claims 30, 35, 36, 38 and 52 have been rejected under 35 USC § 103(a) as being unpatentable over Korhonen, in view of Bobsein, et al. and in further view of US Patent Application Publication No. 2002/0117277 (Johnson, et al.).

**The Teachings of the Cited References**

The cited prior art has been summarized in the previously filed amendment.

**The Rejections Under 35 USC § 103(a) Are Not Supported by the References**

In contrast to the cited references, claim 26 as amended, recites in part:

said roughness level and said gloss value in combination having values that lie within a triangularly shaped region defined by a first point, a second point, and a third point, said first point being 0.8  $\mu$ m roughness level and 3% gloss value, said second point being 0.8  $\mu$ m roughness level and 35% gloss value, said third point being 3.9  $\mu$ m roughness level and 3% gloss value.

(Emphasis added). Applicants submit that such an invention is neither taught, disclosed, nor suggested by Korhonen, Bobsein, et al. or any of the other cited references, alone or in combination, and includes distinct advantages thereover.

Korhonen discloses a method for the manufacture of LWCR printing paper that is coated once and has a PPS-ST roughness below 3.5  $\mu$ m. Bobsein, et al. disclose a paper having a sheet gloss of approximately 30%. Applicants' claimed invention is a method that specifically results in wood-free coated paper with a combination of quality and roughness that lies within the triangularly shaped range of the independent claim.

Applicants' invention surprisingly accomplishes a combination of gloss and roughness that is not obtained by other methods. Furthermore, it is the combination of the two qualities that establish Applicants' method as producing a paper with two desirable qualities in a range accomplished by the steps outlined in the independent claim. The cited prior art does include values for roughness and gloss, but in every case where these values are associated with each other, they lie outside of the area claimed by Applicants. The combination of the cited references does not provide any disclosure where associated roughness and gloss values fall within Applicants' claimed area. This lack of disclosure in the cited references underscores the novelty of Applicants' method. The prior art references when combined teach roughness values that are associated with gloss values that fall outside Applicants' claim.

Table 2 of Bobsein, et al, is instructive to show that roughness (smoothness) and gloss are related and that this table illustrates particulars of the paper made using the Bobsein, et al. method. However, the teaching that they are related underscores that the association of gloss and roughness cannot simply be declared to exist by finding two references that teach one aspect and not the combination of the attributes claimed by the Applicants. Therefore, Korhonen, Bobsein, et al., and any of the other cited references, alone in combination, fail to teach, disclose, or suggest a roughness level and a gloss value in combination having values that lie within a triangularly shaped region defined by a first point, a second point, and a third point, the first point being 0.8  $\mu\text{m}$  roughness level and 3% gloss value, the second point being 0.8  $\mu\text{m}$  roughness level and 35% gloss value, and the third point being 3.9  $\mu\text{m}$  roughness level and 3% gloss value, as recited in claim 26.

The present invention has several advantages, including the ability to produce paper with a combination roughness and gloss value that is uniquely obtained by the steps of the method utilized by Applicants. For the foregoing reasons, Applicants submit that claim 26, and claims 27-29, 32-34, and 37 depending therefrom, are in condition for allowance, the allowance of which being hereby respectfully requested.

Regarding the rejection of claims 30, 35, 36, 38 and 52 under 35 USC § 103(a) as being unpatentable over Korhonen, in view of Bobsein, et al. and in further view of Johnson, et al. Claims 30, 35, 36 and 38 depend from claim 26, which is in condition for allowance for the reasons given above. Regarding claim 52, Applicants respectfully traverse the rejection and submit that claim 52 is in condition for allowance.

In contrast to the cited references, claim 52 recites in part:

drying the paper web by means of at least one device for drying, after the paper web has passed through said at least one device for the application of liquid or pasty application medium in a running direction (L) of the paper web, the paper web is no longer led through any further smoothing or calendering device, and the

wood-free coated paper web is produced having a roughness in the range from 0.8-3.9  $\mu\text{m}$  PPS (Parker Print Surf) and a gloss in the range from 3-35% TAPPI 75° (Specular Gloss of Paper and Paperboard at 75°).

(Emphasis added). Applicants submit that such an invention is neither taught, disclosed, nor suggested by Korhonen, Bobsein, et al. or any of the other cited references, alone or in combination, and includes distinct advantages thereover.

Korhonen discloses a method for the manufacture of LWCR printing paper that is coated once and has a PPS-ST roughness below 3.5  $\mu\text{m}$ . Bobsein, et al. disclose a paper having a sheet gloss of approximately 30%. Johnson et al. disclose a multi-layer printable wear resistant paper, with Figs. 1 and 3 both being schematic diagrams of a papermaking process. These figures show the web hanging in midair, which infers that some further processing will follow, and it does not infer the negative recitation of the claim. These figures and the cited prior art fail to recite the claimed negative limitation. Applicants' claimed invention is a method that specifically excludes the paper web from being led through any further smoothing or calendering device once the paper web has been coated. This is a negative limitation that is discussed in the specification as originally filed and it is used to exclude the prior art as provided for in MPEP 2173.05(i). Full weight of this negative limitation should be given in the evaluation of the claim. The disclosure of this negative limitation is not included in any of the cited references, nor does the combination of the cited references cause the negative limitation to arise. Therefore, Korhonen, Bobsein, et al., Johnson et al. and any of the other cited references, alone in combination, fail to teach, disclose, or suggest the step of drying the paper web by means of at least one device for drying, after the paper web has passed through the at least one device for the application of liquid or pasty application medium in a running direction (L) of the paper web, the paper web is no longer led through any further smoothing or calendering device, and the wood-free coated paper web is produced having a roughness in the range from 0.8-3.9  $\mu\text{m}$  PPS (Parker Print Surf) and a gloss in

the range from 3-35% TAPPI 75° (Specular Gloss of Paper and Paperboard at 75°), as recited in claim 52.

The present invention has several advantages, including the ability to produce paper that once coated does not pass through any smoothing or calendering device with the paper then having a combination roughness and gloss value as specified in the claim. For the foregoing reasons, Applicants submit that claim 52 is in condition for allowance, the allowance of which being hereby respectfully requested.

For the foregoing reasons, Applicants submit that no combination of the cited references teaches, discloses or suggests the subject matter of the amended claims. The pending claims are therefore in condition for allowance, and Applicants respectfully request withdrawal of all rejections and allowance of the claims.

In the event Applicants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefor and authorizes that any charges be made to Deposit Account No. 20-0095, TAYLOR IP, PC. Should any question concerning any of the foregoing arise, the Examiner is invited to telephone the undersigned at (260) 897-3400.

Respectfully submitted,

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